

This Opinion is Not a
Precedent of the TTAB

Mailed: February 8, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re GB II Corporation
d/b/a Columbia River Knife & Tool Company
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Serial No. 88730809
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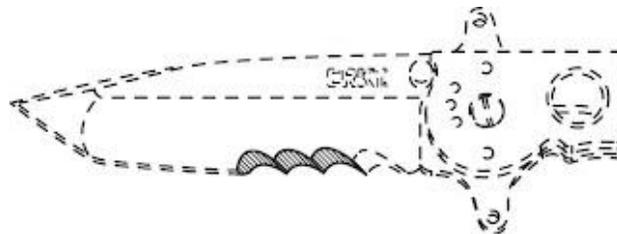
Alexa M. Johnston of Klarquist Sparkman, LLP,
for GB II Corporation d/b/a Columbia River Knife & Tool Company.

Caroline L. Moran, Trademark Examining Attorney, Law Office 125,
Heather Biddulph, Managing Attorney.

—
Before Lykos, Larkin and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

On December 17, 2019, GB II Corporation d/b/a Columbia River Knife & Tool Company (“Applicant”) filed an application to register on the Principal Register the design mark shown below:



claiming that the mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), for “sport and working knives” in International Class 8.¹ The description of the mark in the Application is as follows:

The mark consists of a serration pattern as applied to the blade of a knife. The broken lines indicate placement of the mark on the goods and are not part of the mark.

The Application was accompanied by the following statement to support Applicant’s claim of acquired distinctiveness:

The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

The Trademark Examining Attorney refused registration on two bases: (1) under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the ground that Applicant’s mark, which consists of a three-dimensional configuration of the goods, is a functional design for such goods, and (2) under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051-1052, 1127, on the ground that Applicant’s mark consists of a non-distinctive product design or a non-distinctive feature of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness under Trademark Act Section 2(f).

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for

¹ Application Serial No. 88730809 was filed under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), claiming first use of the mark anywhere and first use in commerce since at least as early as January 10, 2006.

reconsideration, the appeal was resumed. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register on both grounds.

I. The Evidence Made of Record

The specimen of use filed with the Application shows Applicant's product in the following configuration, accompanied by the following description:



Thus, in its advertising, Applicant calls the “serration pattern as applied to the blade of ... [the] knife” the “Veff Serrations.”² In its brief, Applicant describes its mark with more particularity as “the distinct angled shape for the teeth and the angled, semi-circular beveled portions disposed above the cutting edge.”³

The Examining Attorney and Applicant each made of record copies of Applicant's online advertising. The Examining Attorney introduced Applicant's advertising on AMAZON.COM, which says:⁴

² The depiction and description of Applicant's mark are taken from the specimen of use submitted with the Application dated December 17, 2019 at TSDR 10. Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

³ Applicant's Brief, 6 TTABVUE 8.

⁴ Applicant's advertising on AMAZON.COM. Office Action of January 23, 2020 at TSDR 6 and 10.

CRKT M16-14SFG EDC Folding Pocket Knife: Special Forces Everyday Carry, Black Serrated Edge Blade, Tanto, Automated Liner Safety, Dual Hilt, G10 Handle, 4-Position Pocket Clip by Columbia River Knife & Tool.

* * *

Veff Serrations: Some hone edges. Others, like “Edgeologist” Tom Veff, reinvent them. **These patented Veff Serrations makes for superior cutting of cordage, rope, and fibrous materials.** (Emphasis added).

Applicant introduced a copy of the online catalog published on its website, which provides:⁵

Veff™ Serrations are the patented alternative to standard triple point serrations. **The unique Veff™ Serration pattern on our knives creates angled teeth that feed material into the cut as you pull. Think of it like multiple guillotines all set to glide through fibrous materials with surgical precision. They’re easy to sharpen and they work better than traditional serrations.**

Veff™ Flat Top Serrations are an additional alternative to standard triple point serrations. **They’re extremely easy to sharpen and they are easier to manufacture, meaning we can pass that cost savings on to you, the end user. The unique Veff™ Flat Top Serration pattern on our knives creates scalloped edges that feed material into the cut as you pull through fibrous materials.**

Veff™ Serrations are easier to sharpen than traditional triple point serrations. With the Veff™ Sharp or a DIY solution, you can hone your serrations back to surgically sharp in a matter of minutes. (Emphasis added).

Applicant additionally made of record its U.S. design patent that appears to cover the same design mark for which Applicant presently seeks registration:⁶

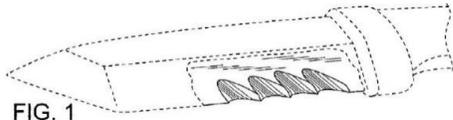
⁵ Applicant’s catalog from <https://www.crkt.com/veff-serrations/>. Office Action Response of July 23, 2020, at TSDR 14-16.

⁶ U.S. Design Patent No. D559, 939 S. Applicant’s Office Action Response of July 21, 2020 at TSDR 10-12.

(12) **United States Design Patent** (10) Patent No.: **US D559,939 S**
Veff, III (45) Date of Patent: **** Jan. 15, 2008**

(57) **CLAIM**

I claim the ornamental design for knife serrations, as shown and described.



DESCRIPTION

FIG. 1 is a perspective view of a serrated knife blade as viewed from the bottom and one side thereof, according to one embodiment.

The dashed lines in the drawings showing particulars of the knife and the location of the serrations along the bottom, cutting edge of the knife are for illustrative purposes only and form no part of the claimed design.

Applicant further introduced Internet users' answers to a question posted on the REDDIT website, as follows:⁷

Anyone Recognize This?



- ↑ R_FN_S1R1US 13 points · 3 months ago
- ↓ Looks like a crkt provoke with veff serrations

- ↑ Koofic 2 points · 3 months ago
- ↓ Crkt provoke

- ↑ NoOneLikeMe05 2 points · 3 months ago
- ↓ CRKT provoke first responder

- ↑ simiwood 2 points · 3 months ago
- ↓ Crkt provoke veff just got one myself last week

- ↑ JPound10 1 point · 3 months ago
- ↓

⁷ Users' answers to question posted on REDDIT. Applicant's Office Action Response of July 21, 2020 at TSDR 18-19.

- Ha, ended up looking that one up.
- ↑ robyr **Benchmade** 1 point · 3 months ago
These VeFF serrations are actually pretty damn slick, and I'd like to see this licensed for others to use.
- ↑ **JPound10** 1 point · 3 months ago
I have mostly plain edge knives, but these are pretty cool looking.
[Continue this thread →](#)
- ↑ Chemicalghst222 1 point · 3 months ago
I was going to buy this until I saw the price....
- ↑ **JPound10** 1 point · 3 months ago
I did some research, and found it's cheaper than the designer's original run of production.

The Examining Attorney made of record several third-party knives having blades with serrated edges:

Wooden Handle Serrated Knife posted on ETSY website:⁸



LASERBITS Serrated Knife posted on JOHNSON PLASTICS website:⁹



⁸ Wooden handle serrated knife posted on ETSY website, Office Action of January 23, 2020 at TSDR 20-21.

⁹ LASERBITS serrated knife posted on JOHNSON PLASTICS website, Office Action of January 23, 2020 at TSDR 26.

LEATHERMAN K2X Serrated Knife posted on REI CO•OP website:¹⁰



LEATHERMAN CRATER C33X Serrated Knife posted on Manufacturer's website:¹¹



GERBER REMIX Serrated Knife posted on REI CO•OP website:¹²



¹⁰ LEATHERMAN K2X serrated knife posted on REI CO•OP website, Office Action of January 23, 2020 at TSDR 29-30.

¹¹ LEATHERMAN CRATER C33X serrated knife posted on manufacturer's website, Office Action of January 23, 2020 at TSDR 36.

¹² GERBER REMIX Serrated Knife posted on REI CO•OP website, Office Action of January 23, 2020 at TSDR 42.

Serial No. 88730809

ESEE Serrated Knife posted on BLADEHQ website:¹



CHRIS REEVE Serrated Knife posted on BLADEHQ website:¹³



¹³ CHRIS REEVE serrated knife posted on BLADEHQ website, Office Action of November 12, 2020 at TSDR 13.

BENCHMADE Serrated Knife posted on BLADEHQ website:¹⁴



With its Request for Reconsideration, Applicant submitted the U.S. registration for the Coca-Cola bottle design:¹⁵



Finally, in response to requests for information by the Examining Attorney, Applicant stated as follows:¹⁶

1. In response to the Examining Attorney's query whether Applicant's mark, or any feature(s) thereof, is or has been the subject of a design or utility patent or patent application, including expired patents and abandoned patent applications, Applicant identified and provided a copy of its U.S. Design Patent

¹⁴ BENCHMADE serrated knife posted on BLADEHQ website, Office Action of November 12, 2020 at TSDR 17.

¹⁵ Coca-Cola bottle design registration, Request for Reconsideration of March 23, 2021 at TSDR 8. Applicant's argument that its patterned serrations compare favorably to the well-known Coca-Cola bottle for purposes of registrability, Applicant's Brief, 6 TTABVUE 9, is without merit. The USPTO must decide each application on its own merits, and decisions regarding other registrations do not bind us. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

¹⁶ Response to Office Action of July 21, 2020 at TSDR 2-3.

No. D 559,939 S. Applicant also identified its U.S. Provisional Application No. 60783602, now expired. Applicant did not provide a copy of this provisional patent application because it was never published or converted into a utility application. The Examining Attorney did not follow up to request a copy of this expired provisional patent application; as such it is not part of the record.

2. In response to the Examining Attorney's request for advertising, promotional, and/or explanatory materials concerning the Applicant's mark, particularly related to its design features, Applicant provided a copy of the online catalog published on its website.
3. In response to the Examining Attorney's query about whether there are alternative designs available for the feature(s) embodied in Applicant's mark, and whether such alternative designs are equally efficient and/or competitive, Applicant pointed to the third-party serrated knives made of record by the Examining Attorney. Applicant further asserted that these third-party serrated knives were equally efficient, efficacious and competitive.
4. In response to the Examining Attorney's query whether Applicant's design at issue results from a comparatively simple or inexpensive method of manufacture in relation to alternative designs, Applicant stated that its design does not result from a simple method of manufacture, nor is it inexpensive to manufacture when compared to alternative designs. Applicant further stated that its design results from a complicated method of manufacture wherein each serration must be individually ground into the knife blade, resulting in additional expense. In contrast, said Applicant, other serration patterns can be ground into a knife all at once, simplifying manufacture and reducing costs. Each serration of Applicant's design, it asserted, costs approximately the same as an entire serration pattern of one of the competitor's knives, making Applicant's applied-for mark 3-4 times more expensive to manufacture.
5. In response to the Examining Attorney's question whether there was any other evidence that Applicant considered relevant to the registrability of its mark, Applicant identified and produced the online question and answers posted at the REDDIT website.

II. Functionality: Applicable Law and Analysis

“The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *5 (TTAB 2020). “[T]rademark ... law can[not] properly make an ‘end run’ around the strict

requirements of utility patent law by giving equivalent rights to exclude.” J. Thomas McCarthy, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:64 (5th ed., Dec. 2021 update). Thus, a product feature or design that is functional is “incapable of serving as a trademark.” *Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1202 (TTAB 2018), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018). Accordingly, Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), prohibits registration of “a mark which ... comprises any matter that, as a whole, is functional.”

There are two types of functionality recognized by controlling case law. One formulation states that “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). This we refer to as “utilitarian functionality.” The other theory of functionality posits “that, if a design’s ‘aesthetic value’ lies in its ability to ‘confe[r] a significant benefit that cannot practically be duplicated by the use of alternative designs,’ then the design is ‘functional.’ ... The ‘ultimate test of aesthetic functionality,’ ... [under this theory], ‘is whether the recognition of trademark rights would significantly hinder competition.’” *Qualitex*, 34 USPQ2d at 1165 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, Comment c, pp. 175-176 (1993)). This we refer to as “aesthetic functionality.” It is clear from our reading of the prosecution history and briefing on this appeal that the refusal to register under Trademark Act Section 2(e)(5) is based on utilitarian functionality and not aesthetic functionality. Neither Applicant nor the Examining Attorney argue otherwise.

The former Court of Customs and Patent Appeals, in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982), suggested four categories of evidence to consider when evaluating utilitarian functionality:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the subject matter sought to be registered;
- (2) advertising by the applicant that touts the utilitarian advantages of the subject matter;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the subject matter results from a comparatively simple or inexpensive method of manufacture.

However, the U.S. Supreme Court has stated that if functionality is established under the *Inwood* test, further inquiry into facts that might be revealed by a full analysis of all types of *Morton-Norwich* evidence is not necessary. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 158 USPQ2d 1001, 1006-07 (2001) (“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. ... There [also] is no need, furthermore, to engage ... in speculation about other design possibilities, ... which might serve the same purpose. ... Other designs need not be attempted.”).

The U.S. Court of Appeals for the Federal Circuit later had occasion to comment on the Supreme Court’s observations in *TrafFix*:

We do not understand the Supreme Court’s decision in *TrafFix* to have altered the *Morton-Norwich* analysis. ... [T]he *Morton-Norwich* factors aid in the determination of whether a particular feature is functional, ... [one] factor focus[ing] on the availability of “other alternatives.” (citation omitted). ... Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court’s observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather ...,

once a product feature is found functional based on other considerations [such as if it “affects the cost or quality of the device,”] there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

Valu Eng’g, Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002).

The Examining Attorney’s functionality refusal is based on application of the *Morton-Norwich* factors. We therefore, on this appeal, consider the *Morton-Norwich* factors to the extent raised in the arguments and based on the evidence made of record. Functionality is a question of fact and depends on the totality of the evidence in each particular case. *Valu Eng’g*, 61 USPQ2d at 1424; *In re MK Diamond*, 2020 USPQ2d 10882, at *5. That being said, it is not required that all four *Morton-Norwich* factors be considered or proven in every case, nor do all four factors have to weigh in favor of functionality to support a functionality refusal. *Poly-America, LP v. Ill. Tool Works, Inc.*, 124 USPQ2d 1508, 1514 (TTAB 2017). However, for sake of completeness, will address each factor below.

A. Utility Patents and Patent Applications

As noted, in response to the Examining Attorney’s Request for Information, Applicant disclosed and made of record a copy of its U.S. Design Patent No. D 559,939 S. Applicant also identified its expired U.S. Provisional Application No. 60783602, but did not provide a copy. Because the Examining Attorney did not follow up with a further request, the provisional patent application is not part of the record and we do not consider it on this appeal. Otherwise, no relevant utility patents (whether active

or expired) or patent applications (whether pending or abandoned) have been identified by Applicant or the Examining Attorney.

Applicant argues that its “design patent is a factor that weighs against a finding of functionality, because design patents by definition protect only ornamental and nonfunctional features.”¹⁷ (quoting the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §1202.02(a)(v)(A) (2020)). Unfortunately this is an incomplete quotation from the noted section of the TMEP, the rest of which is provided in the Examining Attorney’s brief:¹⁸ “However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination.” (citing *In re Becton, Dickinson & Co.*, 675 F. 3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984)).

Here, we find that Applicant’s U.S. Design Patent No. D 559,939 S is a factor weighing against a finding of functionality, but its existence is not determinative.

B. Applicant’s Advertising Touting the Utilitarian Advantages of its Proposed Mark

The Examining Attorney argues that “Applicant’s own advertising ... extols specific utilitarian advantages of the applied-for product design ... [which] is strong evidence that the matter sought to be registered is functional.”¹⁹ (citing *In re Becton,*

¹⁷ Applicant’s Brief, 6 TTABVUE 10.

¹⁸ Examining Attorney’s Brief, 10 TTABVUE 6.

¹⁹ Examining Attorney’s Brief, 10 TTABVUE 8.

Dickinson & Co., 102 USPQ2d at 1377-78; *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1373-75 (TTAB 2015); TMEP § 1202.02(a)(v)(B). We agree.

From Applicant's above-quoted promotional text published on AMAZON.COM and Applicant's own website, we discern the following utilitarian features of the patterned serrations being touted by Applicant in its advertising:

- The serrations make for superior cutting of cordage, rope and fibrous materials by creating angled teeth and scalloped edges that feed material into the cut as the knife user pulls (like multiple guillotines all set to glide through such materials with surgical precision).
- The serrations are extremely easy to sharpen and work better than traditional serrations, enabling the knife user to hone the serrations back to surgically sharp in a matter of minutes.
- The serrations are easier to manufacture, so that Applicant can pass its cost savings on to the end user.

Applicant argues that its

advertising is merely puffery, as there is no empirical evidence provided that suggests Applicant's product functions better than any of its competitors, merely statements of opinion. ... General claims of superiority (such as Applicant's marketing materials, which assert that "Veff Cuts Better") are generally understood to be a mere expression of opinion, particularly advertising claims that a product or service is "superior" or "better." ... Applicant's advertising does not show functionality²⁰

The TMEP anticipates such arguments:

An applicant will often assert that statements in its promotional materials touting the utilitarian advantages of the product feature are mere "puffery" and, thus, entitled to little weight in the functionality analysis. However, where the advertising statements clearly emphasize specific utilitarian features of the design claimed as a mark, the Board will reject such assertions of "puffing."

²⁰ Applicant's Brief, 6 TTABVUE 9-10.

TMEP § 1202.02(a)(v)(B). *See also In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) (the applicant's ad copy "clearly indicates that the particular features of the applicant's configuration ... provide certain acoustical advantages in terms of the sounds the guitar makes. ... We are not persuaded by applicant's argument that this advertisement does not tout the functional features of the guitar shape, but is merely puffery."); *In re Witco Corp.*, 14 USPQ2d 1557, 1560 (TTAB 1989) ("[T]he only real evidence of record relating to the factors set forth in *In re Morton-Norwich* and its progeny is applicant's advertising touting the utilitarian advantages of its container. ... [A]pplicant's only response to this evidence is to suggest that the statements in the promotional material are mere puffing, and that the features referred to in the advertising are not in reality better. This explanation is not persuasive to rebut the specific statements touting the functional advantages of these features").

Here, we find that Applicant's advertising on AMAZON.COM and on its own website clearly tout the utilitarian advantages of the serrations: superior cutting, ease of sharpening over traditional serrations, and ease of manufacture so that Applicant can pass its cost savings on to the end user. This is a strong factor in favor of a finding of functionality. Applicant's assertion that its advertising copy is "mere puffery" is without merit.

C. Availability of Alternative Designs

On the record before us, the existence of third-party knife blade serration designs purportedly competitive with the serration configuration Applicant seeks to register

comes from evidence solely provided by the Examining Attorney. No such evidence was made of record by Applicant. Applicant argues:

Any serration pattern can perform the function of cutting, however there are still a myriad of ways to distinguish the design of one serration pattern from another. Many other serrated knives exist and function very well having serrations that do not resemble Applicant's distinct design. ... Applicant's competitors would not be put at a significant disadvantage by Applicant's applied-for mark, because Applicant is not attempting to register a trademark for serrations generally—only its own specific ornamental design for such. ... The function performed by Applicant's serrated design could be equally well-performed by knives having serrated portions in any of numerous other designs. ... The evidence provided by the Office does not indicate that there are a limited number of designs available at all, in fact, each of the knives shown in the cited evidence has a unique and distinct serration pattern.²¹

The Examining Attorney argues:

Numerous third party examples [have been made of record] of competitor knife serration patterns that are highly similar to ... [Applicant's] mark. ... [T]o the extent that the third party evidence shows serration patterns that are not identical to ... [Applicant's] design, the differences appear to be mere refinements on the same basic design. In this case, the inquiry is whether there are many alternative designs which are both useful and cost effective. Applicant failed to show that these alternative designs work[] equally well or are equally cost effective. Accordingly, this factor weighs in favor of a finding of functionality.²²

If the Examining Attorney is arguing it is Applicant's burden to show, in the first instance, that third-party alternative designs work equally well or are equally cost effective, this is contrary to stated Office policy and controlling case law. Rather,

[t]he [E]xamining [A]ttorney must establish a prima facie case that the proposed trade dress mark sought to be registered is functional in order to make and maintain the [Trademark Act] § 2(e)(5) functionality refusal. ... The burden then shifts to the applicant to present "competent

²¹ Applicant's Brief, 6 TTABVUE 7-9

²² Examining Attorney's Brief, 10 TTABVUE 8-9.

evidence” to rebut the [E]xamining [A]ttorney’s prima facie case of functionality.

TMEP § 1202.02(a)(iv) (citing *In re Becton, Dickinson*, 102 USPQ2d at 1376).

Although we need not consider alternative designs once we find that the patterned serrations are functional based on other evidence, in *TrafFix*, 158 USPQ2d at 1006-07, we do so here for the sake of completeness as “part of the overall mix,” *Valu Eng’g*, 61 USPQ2d at 1427, and because it further supports our finding that Applicant’s proposed mark is functional.

Of the third-party knife designs the Examining Attorney made of record, all of them have angled, semi-circular beveled portions disposed above the cutting edge. However, the WOODEN HANDLE/ETSY, LASERBITS, LEATHERMAN, GERBER REMIX, SPYDERCO and BENCHMADE models all have additional (smaller) teeth on the cutting edge not present in Applicant’s design. The ESEE and Chris Reeve models do not have the additional, smaller teeth, but the semi-circular beveled portions are not as deep as shown in Applicant’s design. It is the specific angled, semi-circular beveled portions disposed above the cutting edge of the patterned serrations as being superior for cutting, easier for sharpening and easier (thus less costly) to manufacture for the ability to pass on cost savings to customers that Applicant touts in its advertising. So, contrary to Applicant’s arguments, the third-party designs provided by the Examining Attorney do not work equally well and are not equally cost effective. To the extent the third-party designs of record are a relevant consideration, we find they support the Examining Attorney’s position that Applicant’s proposed mark is functional.

D. Whether Applicant's Knife Blade Design Results From a Comparatively Simple or Inexpensive Method of Manufacture

With no supporting evidence (such as an employee declaration or manufacturing documentation), Applicant represented during prosecution that its design does not result from a simple method of manufacture, nor is it inexpensive to manufacture when compared to alternative designs. Applicant further represented that its design results from a complicated method of manufacture making Applicant's patterned serrations 3-4 times more expensive to manufacture over competitors' knife blades.²³ Applicant does not appear to have continued these representations in its appeal brief.

These representations made by Applicant during prosecution are belied by its online advertising that the serrations "are easier to manufacture, meaning ... [Applicant] can pass that cost savings on to ... the end user."²⁴ Applicant's website ad copy supports a finding that its knife blade design results from a comparatively simple or inexpensive method of manufacture, and therefore functional.

E. Functionality: Conclusion

The existence of Applicant's design patent covering the patterned serrations is some evidence of non-functionality, but is not conclusive on this question since it is not a utility patent. Applicant's advertising clearly touts the utilitarian and functional advantages of its blade design sought for registration. To the extent it is a relevant consideration, the third-party blade designs made of record do not work

²³ Office Action Response of July 21, 2020 at TSDR 3.

²⁴ Applicant's catalog from <https://www.crkt.com/veff-serrations/>. Office Action Response of July 23, 2020, at TSDR 14-16.

equally well and are not equally cost effective to make according to the representations Applicant made in its online advertising that its knife blade design is easier to manufacture, such that Applicant can pass its cost savings on to the end user. We find that Applicant's knife blade serrations design is utilitarian functional and thus not registrable pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5).

III. Insufficient Evidence of Acquired Distinctiveness: Applicable Law and Analysis

Because we affirm the functionality refusal, it is unnecessary to reach a decision as to whether Applicant's knife blade design has acquired distinctiveness under Trademark Act Section 2(f). Nonetheless, for completeness we address the Examining Attorney's alternative ground for refusing registration under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, that Applicant's mark consists of a non-distinctive product design or non-distinctive feature of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. *In re MK Diamond*, 2020 USPQ2d 10882, at *19.²⁵

A. A Showing of Acquired Distinctiveness Was Required as a Matter of Law in this Case

The Supreme Court has held that “[product] design ... is not inherently distinctive ... and therefore protectable ... only upon a showing of secondary meaning.” *Wal-Mart*

²⁵ During prosecution, Applicant did not respond to the Examining Attorney's invitations for Applicant to seek registration on the Supplemental Register in the event the functionality refusal was overturned. Office Action of January 23, 2020 at TSDR 4; Office Action of November 11, 2020 at TSDR 4. The question of registration on the Supplemental Register was not discussed in any of the briefs on appeal.

Stores, Inc. v. Samara Bros., 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). Product packaging, on the other hand, in certain circumstances may be considered inherently distinctive and protectable without a showing of acquired distinctiveness. *Id.* at 1069. “There ... [are] some hard cases at the margin ... of having to distinguish between product design and product packaging To the extent there are close cases ... [the Supreme Court instructs] that ... [we] should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Id.* at 1069-70.

This is not a “hard case at the margin.” As observed by the Examining Attorney,²⁶ Applicant has sought registration of its mark under Trademark Act Section 2(f), thereby conceding that its mark is not inherently distinctive, *see In Re MGA Ent., Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007) (“[B]y seeking registration under Section 2(f), [A]pplicant has conceded lack of inherent distinctiveness and must prove acquired distinctiveness.”), and again acquired distinctiveness must be shown.

B. Whether Applicant Adequately Demonstrated That Its Knife Blade Design has Acquired Distinctiveness

Because Applicant’s proposed mark is not inherently distinctive, Applicant must prove it has acquired distinctiveness under Trademark Section 2(f) to obtain registration on the Principal Register. *See Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 940 F.2d 1572, 6 USPQ2d 1001, 1007-08 (Fed. Cir. 1988); *In re Integra Biosciences*,

²⁶ Examining Attorney’s Brief, 10 TTABVUE 11.

2022 USPQ2d 93, at *25-26 (TTAB 2022). Whether acquired distinctiveness has been established is a question of fact. *In re Becton, Dickinson*, 102 USPQ2d at 1375.

An applicant faces a heavy burden to establish acquired distinctiveness in an application to register product design trade dress. *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009). A mere statement of five years' use (or longer) is generally not sufficient. *See, e.g., In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (noting the statutory language regarding acquired distinctiveness "is permissive, and the weight to be accorded [evidence of five years of substantially exclusive use] depends on the facts and circumstances of the particular case," and finding evidence of seven to seventeen years of use insufficient to support a claim of acquired distinctiveness). Further, a product design may be incapable of functioning as an indicator of source because it is basic or common in an industry or is a mere refinement of a product design commonly used for the relevant goods. *See Stuart Spector Designs*, 94 USPQ2d at 1555 (noting that a design may be deemed incapable where it is, "at a minimum, so common in the industry that it cannot be said to identify a particular source.").

"To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature ... is to identify the source of the product rather than the product itself." *Inwood Labs.*, 214 USPQ at 4 n.11. We weigh six interrelated factors to determine whether a proposed mark has acquired distinctiveness:

- (1) Association with a particular source by actual purchasers (typically measured by customer surveys);

- (2) Length, degree, and exclusivity of use;
- (3) Amount and manner of advertising;
- (4) Amount of sales and number of customers;
- (5) Intentional copying; and
- (6) Unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. ITC, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018). We may quickly dispense with *Converse* factors 4-6, because Applicant did not make any supporting evidence of record regarding these factors.

In support of Applicant's acquired distinctiveness claim, as we mentioned above, the Application at issue as originally filed contains a claim of Applicant's substantially exclusive and continuous use of the mark in commerce for at least the five years immediately before the date the Application was filed.²⁷ Considering Applicant's heavy burden of proof, this statement is insufficient. *See e.g., In re R.M. Smith*, 222 USPQ at 3 (eight years of use not sufficient to establish distinctiveness in configuration of pistol grip water nozzle for water nozzles); *In re Gibson Guitar*, 61 USPQ2d at 1952 (66 years of use alone insufficient to show acquired distinctiveness of guitar configuration). Applicant's brief states (without a supporting declaration) that it "has been offering its product with the Veff Serrations for 15 years."²⁸ Even if we were to accept this unsupported assertion (which we do not),²⁹ this statement standing alone also does not meet Applicant's weighty factual burden.

²⁷ Application of December 17, 2019 at TSDR 2.

²⁸ Applicant's Brief, 6 TTABVUE 11.

²⁹ "Attorney argument is no substitute for evidence." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *In re Simulations Publ'ns, Inc.*,

We are thus left with two pieces of evidence Applicant submitted to support its contention that the patterned serrations have acquired distinctiveness. First, and foremost, is the content of Applicant's advertising. As the Board previously stated in

Stuart Spector Designs:

[Over and above proof of sales and advertising expenditures], the more important question is how is the alleged mark being used, i.e., in what manner have consumers been exposed to the alleged mark so that we can impute consumer association between the configurations and the product producer. To determine whether a configuration has acquired distinctiveness, advertisements must show promotion of the configuration as a trademark.

[For] Applicant[] to assert[] that it promotes the configurations as trademarks by 'look for' advertising ... [this must be] supported by the record.

"Look for" advertising refers to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non source-identifying manner.

Moreover, "[a]dvertising that touts a product feature for its desirable qualities and not primarily as a way to distinguish the producer's brand is not only not evidence that the feature has acquired secondary meaning, it directly undermines such a finding." *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 USPQ2d 1065, 1071 (7th Cir. 1995)

....

Stuart Spector Designs, 94 USPQ2d at 1572-73.

521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) ("Statements in a brief cannot take the place of evidence."). See also *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *15 (TTAB 2019) (Applicant's "assertions [of non-functionality] are unsupported by sworn statements or other evidence, and 'attorney argument is no substitute for evidence.'").

Here, we have no evidence of record that Applicant's advertisements promote the patterned serrations as a trademark – such that we may impute consumer association between the knife blade serrations themselves and Applicant as the producer. Rather, Applicant's advertising on AMAZON.COM and on its website touts the serrations for their desirable utilitarian qualities rather than as a way to distinguish Applicant's knives from those of its competitors. Applicant's advertising thus undermines any finding that its proposed mark has acquired distinctiveness.

Second, Applicant points us to Internet users' answers to the following question posted on the REDDIT website:

Anyone Recognize This?



In response to this posted question and image, as set out above, five of nine responders correctly identified the name of the product (Veff Serrations) or the initials of the manufacturer (CRKT). This evidence hardly comes close to the reliable results achieved from a well-run trade dress acquired distinctiveness survey. *See Stuart Spector Designs*, 94 USPQ2d at 1569-71 (finding Applicant's acquired distinctiveness survey not particularly probative of acquired distinctiveness, because of numerous design flaws); *see generally* David H.B. Bendall et al., *Color, Champagne, and Trademark Secondary Meaning Surveys: Devilish Detail*, 102 TRADEMARK REP. 967 (2012) (discussing the proper design of a secondary meaning survey).

Based on the foregoing, we find that Applicant's patterned serrations design has not acquired distinctiveness as a trademark for Applicant's sport and working knives

and, therefore, we affirm the Examining Attorney's separate refusal to register the proposed mark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that the patterned serrations are not inherently distinctive and have not acquired distinctiveness under Trademark Act Section 2(f).

Decision:

We affirm the refusal to register Applicant's proposed mark under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the ground that it is functional; and affirm the separate refusal to register the proposed mark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that it is not inherently distinctive and has not acquired distinctiveness under Trademark Act Section 2(f).